

**REMARKS**

Applicant thanks the Examiner for carefully considering the present application. Please reconsider the application in view of the above amendments and the following remarks.

**Disposition of Claims**

Claims 1-5 and 79-97 were pending in this application. New claims 111 and 112 have been added by way of this reply. As such, claims 1-5, 79-97, and 111-112 are currently pending in this application. Claims 1, 3, 4, and 5 are independent. The remaining claims depend, directly or indirectly, from claims 1, 3, 4, and 5.

**Claim Amendments**

Independent claim 5 has been amended by way of this reply. Specifically, independent claim 5 has been amended to remove the term “board” from the preamble and to remove the limitation of “arranging the decorative layer on a supporting substrate.” No new matter has been added by way of this amendment.

**New Claims**

New claims 111 and 112 have been added by way of this reply. New claim 111, which depends from independent claim 5, recites, in part, “arranging the decorative layer on a supporting substrate.” New claim 112, which depends from independent claim 5, recites, in part, “drying the applied mixture at a drying temperature above the melting range of the wax.” Support

for these amendments may be found, for example, within the originally filed claim set and within the published Specification. No new matter has been added.

## **Election**

Applicant hereby elects Species D, on which claims 5, 79-97, and new claims 111-112 read, for continued examination, with traverse.

## **Traversal**

At the outset, Applicant notes that the Examiner's definition of Species D in the Office Action of September 10, 2010 is incorrect. The Examiner defines Species D, claims 5 and 79-97, as a method, in which "the adhesive placement is contact with first film opposite metalized layer." See Office Action of September 10, 2010, page 2. Applicant respectfully asserts that a "first film" and a "metalized layer" are not defined, at all, within claim 5 and 79-97 and, thus, the Examiner's definition of Species D is incorrect.

Additionally, Applicant believes that the Species Restriction is improper. MPEP § 806.03 states that "[w]here the claims of an application define the same essential characteristics of a *single* disclosed embodiment of an invention, restriction therebetween should never be required. This is because the claims are \*not directed to distinct inventions; rather they are different definitions of the same disclosed subject matter, varying in breadth or scope of definition." See MPEP § 806.03.

Referring to Figure 2 of the published Specification, a flow diagram schematically illustrating a *single* exemplary embodiment of the method according to the present invention is shown. The flow diagram of Figure 2 shows every limitation of the amended independent claims in a *single embodiment*. Applicant asserts that independent claims 1, 3, 4, and 5 may cover the *same embodiment* and, thus, any Species Restriction is improper.

Further, considering *arguendo* that a restriction of distinct *inventions* is proper, Applicant respectfully traverses the restriction. Independent claim 3 (Species B) and independent claim 4 (Species C) are directed to the same embodiment, but differ with respect to defining the melting temperature of the wax. Specifically, independent claim 3 defines the absolute melting temperature as 140°C, whereas independent claim 4 defines the melting temperature relative to the press temperature, *i.e.*, 50°C below the press temperature.

Furthermore, independent claim 5 includes *both definitions of the melting temperature of the wax*. Specifically, independent claim 5 recites, in part, that “a melting range of the at least one wax is at least one of below a temperature of about 140°C and by more than 50°C below the press temperature.” New claim 112, which depends from independent claim 5, recites, in part, “drying the applied mixture at a drying temperature above the melting range of the wax.” The limitations of amended independent claim 5, and its dependent claims, are substantially similar to each and every limitation recited within claims 1-2 (Species A), independent claim 3 (Species B), and independent claim 4 (Species C). As such, Applicant respectfully asserts that the claims, as amended, do not impose undue examination and/or search burden under the law. In fact, by examining amended independent claim 5, the Examiner necessarily will search the limitations of independent claims 3

and 4. Thus, all claims in the application would not require a different field of search and should be brought back into the application upon allowance.

Thus, the Examiner's reasons for restricting the claims are clearly erroneous and, thus, the Examiner has failed to establish an appropriate basis for the restriction.


For the benefit of moving the prosecution forward, Applicant elects species D, including claims 5, 79-97, and new claims 111-112 for further prosecution. Applicant reserves the right to pursue the subject matter of the non-elected species in future divisional applications.

#### **Conclusion**

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 50-0591, under Order No. 03850/029001 from which the undersigned is authorized to draw.

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Respectfully submitted,

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